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PRE-APPEAL BRIEF REQUEST FOR REVIEW

	Docket Number (Optional)
	550-299

FACSIMILE CERTIFICATE

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Signature: _____

Typed or printed name: Stanley C. Spooner

Application Number	Filed
10/025,816	December 26, 2001
First Named Inventor	
SLOBODNIK	

Art Unit	Examiner
2133	J. Tabone, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

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The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐   Applicant/Inventor

☐   Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒   Attorney or agent of record   27,393
                                    (Reg. No.)

☐   Attorney or agent acting under 37CFR 1.34.
    Registration number if acting under 37 C.F.R. § 1.34 _____

_____
Signature

Stanley C. Spooner

_____
Typed or printed name

703-816-4028
Requester's telephone number

September 1, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒   *Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following listing of clear errors in the Examiner's rejection and/or the Examiner's

omissions of essential elements for a *prima facie* basis for rejection are responsive to the Final

Rejection mailed June 2, 2005 (Paper No. 05232005) and are set out in correspondence with the

errors as they exist chronologically in the Final Rejection.

1. The Examiner has apparently failed to properly construe the subject matter recited in Applicants' independent claims 1 and 18.

Applicants' independent apparatus claim 1 and method claim 18 requires "a self-test

instructions specifying a test methodology." Claims 1 and 18 further require that the self-test

controller be configurable "by said self-test instruction to implement different memory test

methodologies." The Examiner appears to misunderstand the well-known definition of

"methodology" as comprising a single step. The conventional definition of methodology is

reflected in the definition contained in Webster's 9th New Collegiate Dictionary, i.e., "a body of

methods, rules, and postulates employed by a discipline: a particular procedure or set of

procedures. The emphasis in the definition is on the fact that methodology is not a single step,

rule, or postulate and rather is a sequence of a plurality of steps, rules, and/or postulates, etc.

At no point in the final rejection does the Examiner construe the word "methodology" or

the phrase "test methodology" to encompass only a single step, rule, or postulate. Moreover, the

Examiner has also failed to support his interpretation of "methodology." Because claim terms

are given their ordinary meaning, the Examiner is obligated to construe the term "methodology"

as meaning a plurality of steps, tests, procedures, postulates, etc.

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In view of the above, the Examiner has improperly construed independent claims 1 and

18 suggesting that "test methodology" encompasses a single test or step or postulate.

2. The Lo reference clearly fails to include structures and method steps in the properly construed independent claims 1 and 18.

The Court of Appeals for the Federal Circuit has noted in the case of *Lindemann*

Maschinenfabrik GMBH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984) that

"[a]nticipation requires the presence in a single prior art reference disclosure of each and every

element of the claimed invention, arranged as in the claim."

(a) Lo does not show or suggest a self-test controller which (is responsive to a self-test

instructions specifying a test methodology" - The Examiner states in the final rejection page 4,

section 4 that "Lo discloses that the ABIST engineer 12 (self-test controller) receives a 9 bit

word 13 from a Micro-code Array 10 which stores a set of test program codes scanned-in prior to

ABIST test (self-test controller configured by self-test instruction)." In effect, the Examiner

alleges that one of the Lo 9 bit microcode words specifies the claimed "a test methodology."

However, in Lo, the Microcontroller stores up to eight 9-bit microcode words, but none

of the 9-bit words can be used to specify a test "methodology" because they teach only a single

step. In fact, all of the eight 9-bit Micro-code words are needed to implement a single test

methodology.

The Lo reference provides various examples (1-17) as to how different test

methodologies are implemented, e.g., a plurality (eight, in the listed examples) of the 9-bit words

are needed in order to define each single test methodology. The Examiner has simply failed to

point out where any test methodology is defined by the claimed single "self-test instruction" in

the Lo reference. While the Examiner asserts that "a self-test instruction is used to specify a test

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methodology to be applied by the self-test controller" (final rejection page 3, lines 4 and 5), the

Examiner does not indicate where this is present in the Lo reference. In fact, the Examiner fails

to indicate anything in the Lo reference which comprises a "single self-test instruction" which

specifies a test methodology which comprises a plurality of steps. At best, Lo contain a series of

eight microcode words, each word specifying a single step and the accumulation of the eight

microcode words specifies a test methodology.

As properly construed, the Examiner fails to point out how and where Lo teaches

Applicants' claimed "self-test controller" which is "responsive to a self-test instruction

specifying a test methodology."

(b) Lo does not teach a self-test controller which may be "configured by said self-test

instruction to implement different memory test methodology." - As noted above, the Examiner

misunderstands Lo teaching of a test methodology created by eight 9-bit microcode words with a

single "self-test instruction" which specifies a test methodology comprised of a plurality of steps.

The Examiner does not indicate how or where there is any disclosure in the Lo reference

of a self-test controller which "may be configured by said self-test instruction." Should

Applicants have missed something in the Final Rejection which identifies a teaching in the Lo

reference, an identification of the specific column and line number and, indeed, the number of

the element alleged to be "self-test controller," the "self-test instruction" which specifies a "test

methodology" is respectfully requested.

(c) There is no basis for rejection under 35 USC §102 - Absent a teaching of Applicants'

claimed "self-test controller" in independent apparatus claim 1 or the "passing" step in

independent method claim 18, the Examiner has failed to establish a prima-facie case of

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anticipation under 35 U.S.C. §102 and in any further rejection thereunder is respectfully

traversed.

3. The Examiner does not allege that the missing teaching from Lo (of a "self-test controller" which is responsive to "a self-test instruction" which specifies a "test methodology") is taught in the Gold reference (US-2003/0167428 A1) or the Correale (US Patent 6,001,662).

If Applicants claimed subject matter (the element in claim 1 and the method step in

claim 18) is missing from the Lo reference, it is incumbent upon the Examiner to demonstrate

how or where that missing teaching is taught in the other cited references in order to establish a

prima facie case of obviousness under 35 U.S.C. §103.

Here, the Examiner has not indicated how or where either the Gold reference or the

Correale reference teaches the missing subject matter from Applicants' specifically claimed

"self-test controller." As a result, the Examiner does not have support for a *prima facie* case of

obviousness under 35 U.S.C. §103.

4. The Examiner fails to provide any "reason" or "motivation" for combining any of the Lo/Gold/Correale references.

As set out in the case of *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998), the Court

of Appeals for the Federal Circuit requires the Examiner "to show a motivation to combine the

references that create the case of obviousness." The court goes on to note that "the Examiner

must show reasons that the skilled artist, confronted with the same problems as the inventor and

with no knowledge of the claimed invention, would select the elements from the cited prior art

references for combination in the manner claimed."

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The Examiner has simply ignored this requirement of showing some reasons or

motivation for combining the bits and pieces of the Lo, Gold, or Correale references in the

manner set forth in the final rejection. Thus, the Examiner has simply failed to set out a *prima*

facie case of obviousness.

SUMMARY

Quite clearly, the Examiner has failed to properly construe the term "test methodology"

set out in Applicants' claims 1 and 18, has ignored his obligation to show where the cited prior

art references disclose the properly construed "self-test controller" and has failed to indicate how

or why one of ordinary skilled in the art would be motivated to combine two of the above three

references. As a result, there is simply no support for any rejection of the independent claims 1

and 18 or the claims dependent thereon under 35 U.S.C. §102 or §103.

Applicants respectfully request that the Pre-Appeal Panel find that this application is

allowed on the existing claims and prosecution remains closed.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____
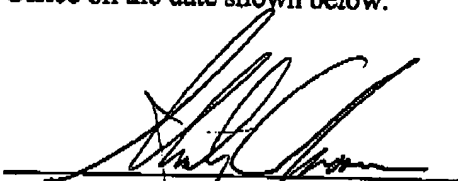   Stanley C. Spooner
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the Notice of Appeal, the Pre-Appeal Brief Request for Review Cover Sheet, and this five-page Statement are all being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Stanley C. Spooner
Reg. No. 27,393

9/1/05
Date

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